

**CUSTOMER NO.: 24498****Serial N . 09/914,683**

Reply to Examiner's request for priority document

**PATENT  
PD990013****REMARKS**

The Examiner requested a copy of a priority German Patent application 19909367.9 having a filing date of March 03, 1999 from which the above identified Patent application claims priority. Such a copy is submitted herewith.

In addition, in a Final Office Action, the Examiner stated that claims 1-7 are pending in the application and that claims 1-7 stand rejected. The Applicant respectfully submits that none of these claims now pending in the application are anticipated under the provisions of 35 U.S.C. § 102 or rendered obvious under the provisions of 35 U.S.C. § 103 for at least the reasons recited below. Thus the Applicant believes that all of these claims are now in allowable form.

**Rejections****A. 35 U.S.C. § 102**

The Examiner rejected the Applicant's claims 1-2 and 4-7 under 35 U.S.C. § 102(a) as being anticipated by Chung (EP 0953 977A1). The rejection is respectfully traversed.

The Applicant would like to respectfully point out to the Examiner that the Chung reference is an improper 102(a) reference. More specifically, 35 U.S.C. § 102 indicates that a person shall be entitled to a patent unless - (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The Applicant submits that the above identified U.S. patent application is a national stage patent application of a PCT application that was filed on February 21, 2000. The PCT application and the national stage application both claim priority to a German Patent application 19909367.9 having a filing date of March 03, 1999. As such, the effective filing date for purposes of prior art for the above identified national stage patent application is March 03, 1999. As such and because the publication date of the Chung reference is November 03, 1999, the Applicant respectfully submits that the Chung reference can not be applied as a proper 102(a) reference under the provisions of 35 U.S.C. § 102. In addition it should be noted that the filing date of the Chung reference is April 03, 1999, and

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as such can not be used as a prior art reference at all against the above identified patent application.

Therefore, the Applicant submits that for at least the reasons recited above independent claim 1 is not anticipated by the teachings of Chung under the provisions of 35 U.S.C. § 102 and, as such, fully satisfies the requirements of 35 U.S.C. § 102 and is patentable thereunder.

Furthermore, the Applicant submits that for at least the reasons recited above, dependent claims 2- 7, which depend either directly or indirectly from independent claim 1 and recite additional features therefore and have the same effective filing date, are also not anticipated by the teachings of Chung under the provisions of 35 U.S.C. § 102 and, as such, fully satisfy the requirements of 35 U.S.C. § 102 and are patentable thereunder.

#### **B. 35 U.S.C. § 103**

The Examiner rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Chung in view of Nordling (U.S. Patent 5,943,391). The rejection is respectfully traversed.

The Examiner applied Chung for the rejection of claim 3 as applied above for the rejection of the Applicant's claim 1. As stated above with regards to at least claim 1, the Applicant would like to respectfully point out to the Examiner that the Chung reference is an improper 102(a) reference. That is, the Applicant submits that the above identified U.S. patent application is a national stage patent application of a PCT that was filed on February 21, 2000. The PCT application and the national stage application both claim priority to a German Patent application 19909367.9 having a filing date of March 03, 1999. As such, the effective filing date for purposes of prior art for the above identified national stage patent application is March 03, 1999. As such and because the publication date of the Chung reference is November 03, 1999, the Applicant respectfully submits that the Chung reference can not be applied as a proper 102(a) reference under the provisions of 35 U.S.C. § 102.

Furthermore, the Applicant further submits that Chung is an improper 103(a) reference. That is, 35 U.S.C. § 103 indicates that (a) - A patent may not be obtained though the invention is not identically disclosed or described as set forth

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in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The Applicant respectfully submits that the subject matter sought to be patented and the prior art are such that the subject matter as a whole would not have been obvious at the time the invention was made to a person having ordinary skill in the art because at the time the invention of the Applicant was made, the Chung reference had not yet been published. As such, the Chung reference can not be properly applied as a prior art reference against the Applicant's present application under 35 U.S.C. § 103(a). In addition it should be noted that the filing date of the Chung reference is April 03, 1999, and as such can not be used as a prior art reference at all against the above identified patent application.

In addition, the Applicant submits that the teachings of Nordling alone, also fail to teach, suggest or make obvious the invention of the Applicant, at least with regards to independent claim 1. That is, the teachings of Nordling for a method and device for a debugger and test data collector, fail to teach, suggest or make obvious at least a method for recording real-time files containing real-time data including at least that "rules for recording the real-time files are derived from the real-time file attributes in order to ensure that the real-time properties of the real-time files are preserved during the recording process" as taught in the Applicant's Specification and claimed by at least the Applicant's claim 1 and as such dependent claim 3.

Therefore, the Applicant submits that for at least the reasons recited above dependent claim 3 is not rendered obvious by the teachings of Chung and Nordling, alone or in any allowable combination, under the provisions of 35 U.S.C. § 103 and, as such, fully satisfies the requirements of 35 U.S.C. § 103 and is patentable thereunder.

#### Applicant's Note

In a telephone conversation of May 19, 2006 at approximately 2:15 p.m. with the Examiner's supervisor, Mr. Thai Q. Tran, Examiner Tran conceded that

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the Chung reference is an improper 35 U.S.C. § 102 and 35 U.S.C. § 103 reference because the publication date and filing date fail to pre-date at least the filing date of the earliest priority application of the Applicant's above identified patent application. The Applicant is including herewith a copy of a priority German Patent application 19909367.9 having a filing date of March 03, 1999 from which the above identified Patent application claims priority.

As such, the Applicant respectfully submits that the present Final Office Action be withdrawn and that the above identified patent application be allowed.

**Conclusion**

Thus the Applicant submits that none of the claims, presently in the application, are anticipated under the provisions of 35 U.S.C. § 102 or rendered obvious under the provisions of 35 U.S.C. § 103. Consequently, the Applicant believes that all these claims are presently in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion, it is respectfully requested that the Examiner telephone the undersigned.

No fee is believed due. However, if a fee is due, please charge the additional fee to Deposit Account No. 07-0832.

Respectfully submitted,  
Marco Winter

By: \_\_\_\_\_

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